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EXAMINER

THAI, HANH B

ART UNIT	PAPER NUMBER
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2163

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/733,274

Applicant(s)

TRIBBENSEE, BRUCE

Examiner

Hanh B. Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on communication received on 12/21/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-75 and 77-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-75 and 77-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/7/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is Non-Final Office Action in response to communication received on December 21, 2006. Claims 57-75 and 77-84 are pending in this application.

Response to Arguments

2. Applicant's arguments regarding "the server making a request from another server ... is not in any way equivalent to a user making a request" (page 12) have been fully considered but they are not persuasive.

Examiner response: this argument is not persuasive because without knowing where the user location and without a request from the user who has traveled elsewhere, the server would not know when or where to make a copy. Thus, having a server making the request is a step ahead which would inherently including user making a request.

3. Applicant argues: "Tso does not teach or suggest a system where a user specifically requests a server to perform certain actions and send a response" (page 11).

Examiner responds: Tso clearly discloses that the user sends a message request to InfoCast server to request the user's record or information (see col.5, lines 16-18 and col.8, lines 48-57, Tso) and thus this teaching reads on the claimed "the user's message to request one or more actions to be taken by a server."

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-75 and 77-84 are rejected on the ground of nonstatutory double patenting over claims 1-40 of U. S. Patent No. 7,146,381 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

	'274	'381
claim	57	1
	59	3
	62	2
	78	36
	80	40
	82	19

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 57-81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, applicant did not point out where in the specification is supported for the claimed limitation “a user to originate a message”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 57-59, 62-65, 67-69, 71-76, 78-79 and 80-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al. (U. S. Patent no. 6,047,327) in view of Takahashi et al. (US 5,819,261).

Regarding claim 57, Tso discloses a server in a client-server environment to receive messages from a client with user interface and messaging system (Fig.3) the user's message to request one or more actions to be taken by a server (Fig.4), the server comprising:

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- a communication unit to receive the message from the client (Fig. 1, col.7, lines 30-40; col.8, lines 1-57; col.11, lines 35-46 and col. 23, lines 51-57).
“communication system” (Fig.1) corresponds to “Communication unit”;
- a parser to identify a keyword in a message, the keywords to select one or more connector files that specify actions to be taken by the system by interacting with one or more external data servers accessible to the system (Fig.4, col. 13, lines 4-8; col.16, lines 1-9 and col.17, lines 19-30). “full story text” and “video” are the keywords;
- an action logic (Fig. 9) to perform the action “logical database” (col. 5, lines 1-11, Tso) specified in the connector file that is connected between “INFOBITE” and “RESOURCES” (93, 95, Fig. 4, Tso) to indicate an action associated with the keyword “FULL STORY TEXT,VIDEO,...” (see Fig. 4, Tso) by interacting with the external data servers in accordance received in responses from the external data servers and assembling a response message for the user (col.4, lines 54-64; col.5, lines 1-30; col.8, lines 1-57 and col.11, lines 13-18. The server in California is interacting with the external server in New York); a filtering mechanism (col.10, lines 41-61) to extract information receive in responses from the external data servers and assembling a response message for the user (col.13, lines 26-34; Fig.5, steps “103-107” and corresponding text); and a sending unit to transmit the response message back to the client via the communication units of the server (col.10, lines 26-40).

Tso, however, does not disclose a user originated messages or a user input including a user originated message and using a key word extracted from a message to request action. Takahashi disclose method and apparatus for extracting a keyword from scheduling data using the keyword for searching the schedule data file including receiving the input text data from a user and a key word extracted from the text data to conduct a request (abstract; col.1, line 65 to col.2, line 2; col.9, lines 62-67 and col. 10, lines 57-66, Takahashi). The “input text data” is equivalent to “a user input including a user originated message”. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the input mechanism and extracted keyword of Takahashi to derive the invention as claimed. The motivation of doing so would have been to avoid a heavy load on the user (col.2, line 59 to col.3, line 3, Takahashi).

Regarding claim 58, Tso/Takahashi combination discloses that wherein the communications unit further receives a formatted response to the request message, and the user interact further presents requested results and information to the user (col. 10, lines 41-61, col. 21, lines 5-10 and col. 25, lines 3-24, Tso).

Regarding claim 59, Tso/Takahashi combination discloses that the user interface further provides feedback to the user upon detection of the one or more keywords, indicating that an action will be taken in response to the keywords (Fig.4 and col.11, lines 58-64, Tso).

Regarding claims 62-63, Tso/Takahashi combination discloses the user interface to prompt the user as to the specific action to be taken in response to the keyword detected in the

message (col. 8, lines 48-64 and Fig.3, Tso). The “InfoAction API” corresponds to the user Interface.

Regarding claim 64, Tso/Takahashi combination discloses the user enters information if a predefined format for inclusion in the user-supplied text (col.25, lines 14-19, Tso).

Regarding claim 65, Tso/Takahashi combination discloses that the format includes specific fields when multi-field data is to be included in the request (Tso, col.8, Table 1 contains format fields to be included in the request).

Regarding claim 67, Tso/Takahashi combination discloses that the request message sent by the client messaging system comprises one or more of the following: some of the message entered by the user, other information extract from the system specific to the user, and context information obtained from the client portion of the system (col.8, lines 1-64. The user must enter a keyword or message sentence to execute a command to retrieve a resource, Tso).

Regarding claim 68, Tso/Takahashi combination discloses that the actions utilize data from one or more of the following: the message entered by the user (col.8, lines 1-64), additional message content data in pre-store connector files, additional information extracted from the system specific to the user and context data (Tso step 103, Fig.5 showing the “time of date and location of user” corresponds to “additional information”).

Regarding claim 69, Tso/Takahashi combination discloses that the user request is received as a text message (col.7, lines 30-67 and col.10, lines 10-40, Tso).

Regarding claim 71, Tso/Takahashi combination discloses that the action logic executes one or more of the following actions: posting information to an external database, querying an external database, querying an external web page, posting to an external web page, and

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combining information fetched from sources internal or external to the system with data contained in the message received from the client and depositing the result into one or more external destinations (col.5, lines 1-30. The server system in California is external to the server system in New York, Tso).

Regarding claim 72, Tso further discloses the action logic executes several actions in sequence in a multi-step response to the action message entered at the client (Tso, col.8, lines 1-64. The user has to enter a keyword to execute a command to retrieve a resource)

Regarding claim 73, Tso/Takahashi combination discloses that the action logic completes the actions of logging the user in to an external data server requiring password access, and then completing the action called for by the action message entered at the client (col.3, lines 9-18, Tso).

Regarding claim 74, Tso/Takahashi combination discloses that the response is placed in a format appropriate for the user's display device (col.25, lines 3-19, Tso).

Regarding claim 75, Tso/Takahashi combination discloses a communication unit to send the response to a destination (col.7, lines 30-40; col.8, lines 1-57; col.10, lines 26-40; col.11, lines 35-46 and col. 23, lines 51-57, Tso)

Regarding claim 76, Tso/Takahashi combination discloses a list of connector files to invoke various actions (Fig.4, Tso).

Regarding claim 78, Tso discloses a client-server system with a client with user interface and messaging system, the user's message to request one or more actions to be taken by a server, the client further comprising:

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- a parser to detect one or more keywords in the message, the keywords to select one or more connector files that specify actions to be taken by the server by interacting with one or more external data servers accessible to the server (Fig.4, col. 13, lines 4-9; col.16, lines 1-9 and col.17, lines 19-30). “full story text” and “video” are the keywords;
- a messaging unit to transmit messages (79, Fig.3) to the server based on the contents of the user's message and the selected one or more connector files, the messaging unit to receive a response generated by an action Logic in the server which performs the actions specified by the connector files, the response assembled by a filtering mechanism within the server (col.10, lines 26-40, Fig.3 and corresponding text).

Tso, however, does not disclose a user originated messages or a user input including a user originated message and using a key word extracted from a message to request action. Takahashi disclose method and apparatus for extracting a keyword from scheduling data using the keyword for searching the schedule data file including receiving the input text data from a user and a key word extracted from the text data to conduct a request (abstract; col.1, line 65 to col.2, line 2; col.9, lines 62-67 and col. 10, lines 57-66, Takahashi). The “input text data” is equivalent to “a user input including a user originated message”. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the input mechanism and extracted keyword of Takahashi to derive the invention as claimed. The motivation of doing so

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would have been to avoid a heavy load on the user (col.2, line 59 to col.3, line 3, Takahashi).

Regarding claim 79, Tso/Takahashi combination discloses that the client connectors are downloaded from a central connector catalog (col. 24, lines 18-33 and line 55-col.25, line 2, Tso).

Regarding claim 80, Tso discloses a messaging system comprising:

- a database of keywords, each keyword having an associated connector file (“Infobite database” contains keyword “full story text” having associated connection to “resource database”, Fig.4);
- a user interface (“Inforaction” 87, Fig.3),
- a parser to detect the one or more keywords in the message (Fig.4, col. 13, lines 4-9; col.16, lines 1-9 and col.17, lines 19-30). “full story text” and “video” are the keywords,
- a messaging unit (element 67, 79, Fig.3) to assemble a request message based on the message, and
- a communications unit to transmit the request “Communication system” (Fig.1) corresponds to “Communication unit” to send response with a result from the action (ACTIONS, 94, Fig. 4). When the keyword in the action in the Infobite (Fig. 4, Tso) is actively performed, it will receive a responsive result to that action displayed in Resources (95, Fig. 4).

Tso, however, does not disclose a user originated messages or a user input including a user originated message and using a key word extracted from a message to request action.

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Takahashi disclose method and apparatus for extracting a keyword from scheduling data using the keyword for searching the schedule data file including receiving the input text data from a user and a key word extracted from the text data to conduct a request (abstract; col.1, line 65 to col.2, line 2; col.9, lines 62-67 and col. 10, lines 57-66, Takahashi). The “input text data” is equivalent to “a user input including a user originated message”. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the input mechanism and extracted keyword of Takahashi to derive the invention as claimed. The motivation of doing so would have been to avoid a heavy load on the user (col.2, line 59 to col.3, line 3, Takahashi).

Regarding claim 81, Tso/Takahashi combination discloses a central database of connector files (database 50, Tso), each connector file associated with a keyword, users downloading the connectors from the central database, a user interface to enable a user to edit, add, and delete keywords associated with downloaded connectors (see col. 24, lines 18-33, Tso).

Regarding claim 82, Tso discloses a messaging system comprising:

- a user interface (“Inforaction” 87, Fig.3),
- a messaging unit (element 67, 79, Fig.3) to assemble a request message based on the message, the messaging unit further to add additional information to the request message,
- a parser to detect one or more keywords in the message, the keywords to select one or more connector files that specify actions to be taken by the system by interacting with one or more external data sewers accessible to the system

(Fig.4, col. 13, lines 4-9; col.16, lines 1-9 and col.17, lines 19-30). “full story text” and “video” are the keywords,

- an action Logic (Fig. 9) to perform the action “logical database” (col. 5, lines 1-11, Tso) specified in the connector file that is connected between “INFOBITE” and “RESOURCES” (93, 95, Fig. 4, Tso) to indicate an action associated with the keyword “FULL STORY TEXT,VIDEO,...” (see Fig. 4, Tso) by interacting with the external data servers in accordance received in responses from the external data servers and assembling a response message for the user (col.4, lines 54-64; col.5, lines 1-30; col.8, lines 1-57 and col.11, lines 13-18. The server in California is interacting with the external server in New York); a filtering mechanism to extract information receive in responses from the external data servers and assembling a response message for the user (col.13, lines 26-34; Fig.5, steps “103-107” and corresponding text) (Fig. 9) to perform the action “logical database” (col. 5, lines 1-11, Tso) specified in the connector file that is connected between “INFOBITE” and “RESOURCES” (93, 95, Fig. 4, Tso) to indicate an action associated with the keyword “FULL STORY TEXT,VIDEO,...” (see Fig. 4, Tso) by interacting with the external data servers in accordance received in responses from the external data servers and assembling a response message for the user (col.4, lines 54-64; col.5, lines 1-30; col.8, lines 1-57 and col.11, lines 13-18. The server in California is interacting with the external server in New York);

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- a filtering mechanism to extract information receive in responses from the external data servers and assembling a response message for the user (col.13, lines 26-34; Fig.5, steps “103-107” and corresponding text; and
- a sending unit to transmit the response message back to the user (col.10, lines 26-40).

Tso, however, does not disclose a user originated messages or a user input including a user originated message and using a key word extracted from a message to request action. Takahashi disclose method and apparatus for extracting a keyword from scheduling data using the keyword for searching the schedule data file including receiving the input text data from a user and a key word extracted from the text data to conduct a request (abstract; col.1, line 65 to col.2, line 2; col.9, lines 62-67 and col. 10, lines 57-66, Takahashi). The “input text data” is equivalent to “a user input including a user originated message”. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the input mechanism and extracted keyword of Takahashi to derive the invention as claimed. The motivation of doing so would have been to avoid a heavy load on the user (col.2, line 59 to col.3, line 3, Takahashi).

Regarding claim 83, Tso/Takahashi combination discloses that the additional information comprises information extracted from the user's system (col.24, lines 18-33, Tso).

Regarding claim 84, Tso/Takahashi combination further discloses that the additional information comprises context information, such as: location and time of day (col.21, lines 5-32, Tso).

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7. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al. (U. S. Patent no. 6,047,327) in view of Takahashi et al. (US 5,819,261) and further in view of Senn et al. (US 6,151,610).

Regarding claim 70, Tso and Takahashi combination discloses all of the claimed limitations as discussed above, except that the user input comprises a speech input mechanism and the system further comprises a speech-to-text converter. Senn discloses a speech recognition which is able to convert sound information into text (col.21, line 50-col.22, line 65, Senn). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tso and Takahashi to include the claimed feature as taught by Senn. The motivation of doing so would have been to provide a specialized system be able to carry out multi-threaded execution such as speech-to-text conversion (col.1, lines 25-30, Senn).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B. Thai whose telephone number is 571-272-4029. The examiner can normally be reached on Mon-Thur (7:00AM - 4:30 PM).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hanh B Thai
Examiner
Art Unit 2163

March 15, 2007



ALFORD KINDRED
PRIMARY EXAMINER